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10/719,120	11/21/2003	Michael R. McGovern	85524CEB	1800

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Thomas H. Close  
Patent Legal Staff  
Eastman Kodak Company  
343 State Street  
Rochester, NY 14650-2201

EXAMINER

KIM, SANG K

ART UNIT PAPER NUMBER

3654

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/719,120

Applicant(s)

MCGOVERN ET AL.

Examiner

SANG KIM

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Non-final 2/23/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. 10/719578. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the limitations of this application are obviously encompassed in claims 1-5 of copending application No. 10/719578, the claims differing only in insubstantial wording and language changes.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 10/719444. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the limitations of this

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application are obviously encompassed in claims 1-15 of copending application No. 10/719444, the claims differing only in insubstantial wording and language changes.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Objections***

Claim 1-10 are objected to because of the following informalities: In claim 1, line 6, "first contact surface" should be --a first contact surface--; In claim 6, line 2, "cylindrical support" should be --cylindrical single support--. Appropriate corrections are required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vackier et al., U.S. Patent No. 4281805.

With respect to claim 1, Vackier '805 shows a generally cylindrical single support structure (12) having an outer web wrapping surface for receiving at least one convolution of a web (13), the outer web wrapping surface and a first contact surface of

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said at least one convolution produce a static coefficient of friction  $x_1$ , and wherein said first contact surface of said at least one convolution of said web and a second contact surface of an at least a partial second convolution of said web produces a static coefficient of friction  $x_2$ , wherein  $x_1$  is less than  $x_2$ , see column 1, lines 10-60, and column 2, lines 15-25.

Vackier '805 does not show the web wrapping surface having a surface texture less than .5 microns.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the apparatus of Vackier '805 with a surface texture less than .5 microns since the surface needs to have some sort of friction to engage the web to the core, but at the same time not too much of friction can be applied, which can cause the irregularities on the outer surface or even damage the web. Vackier '805 already shows a static coefficient of friction  $x_1$  is less than a second contact surface that has a static coefficient of friction  $x_2$ , and it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

Claims 2-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vackier et al., U.S. Patent No. 4281805, in view of Akao et al., U.S. Patent No. 4989802.

With respect to claims 2-5, Vackier '805 does not explain the material of the core.

Akao '802 teaches the core may be any thermoplastic resin or contain other known additives, see column 4, lines 28-31, and column 8, lines 13-17.

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Vakier in view of Akao does not show a certain type of plastic, such as, amorphous thermoplastic resins, semi-crystalline thermoplastic resins, polycarbonate, silicone polycarbonate copolymers, polybutylene-terephthalate and polybutylene-terephthalate, but does teach other plastic material resin or contain other known additives.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the apparatus of Vakier in view of Akao with amorphous thermoplastic resins, semi-crystalline thermoplastic resins, polycarbonate, silicone polycarbonate copolymers, polybutylene-terephthalate and polybutylene-terephthalate, since other known additives can be used to make the core.

Furthermore, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

With respect to claims 6-10, Vakier '805 does not explain the material specification, which contains a tensile strength, flexural strength and Rockwell hardness.

Akao '802 teaches the bending elastic modulus, the Izod impact strength and the Rockwell hardness (i.e., more than 90 R), see column 4, lines 62-68, and column 5, lines 1-25.

Vakier in view of Akao does not show a certain tensile strength and flexural strength of the material to ensure that the material can handle the web to the highest quality.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the apparatus of Vakier in view of Akao with a certain tensile strength and flexural strength, since any plastic material has a characteristics of a tensile strength, flexural strength and Rockwell R hardness when tested and other known additives can be used as a reinforcing agent.

Furthermore, it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

### ***Response to Arguments***

Applicant has failed to provide information on copending applications prior to the Office action mailed on 11/17/04. Applicant submits amendments to the specification on 2/23/05, providing other copending applications. The provisional double patenting rejection is set forth above for each application.

Claims 1 and 7-10 have been amended.

Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The added recitation that the generally cylindrical single support necessitated the new grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SANG KIM whose telephone number is 571-272-6947. The examiner can normally be reached Monday through Friday from 8:00 A.M. to 5:30 P.M. alternating Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathy Matecki, can be reached on (571) 272-6951. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.



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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SK

4/25/05

*Kathy Matecki*  
KATHY MATECKI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600